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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,096	04/01/2005	Masashi Kudo	121036-0078	5558

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/530,096

Applicant(s)

KUDO ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/1/05 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/1/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. The Applicants' preliminary amendment filed on April 1, 2006 is acknowledged. Claims 1, 4, 6, 9, 13-14, 17-18, 20, 22 and 24-31 are amended. Claims 32-33 are added. Now, Claims 1-33 are pending.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

Applicants are advised to provide the page number for each page.

Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an

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invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 7-9, 11-18 and 25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-10 of copending Application No. 10/506,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claims 1-10 of the copending Application are directed to materials comprise a cured product of specific compositions, which obviously read on the materials of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 11-17, 25-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by JP255 (JP 2000-154255).

For Claim 1, JP255 discloses a sealing material comprising A) an acrylic polymer containing at least one alkenyl group, B) a hydrosilyl group-containing compound and a hydrosilylation catalyst. ([0005], [0078], [0086] and Examples) For Claims 2-9, 11-17, 25-31 and 33, Component A) can be derived from ethyl acrylate, n-butyl acrylate, 2-methoxyethyl acrylate and 1,7-octadiene. ([0008], [0032] and Examples) The molecular weight distribution of Component A) can be 1.8 or less. ([0010]) The molecular weight of Component A) is described in [0011]. The hardness of the cured composition is exemplified in [0094]. A filler can be used. ([0081]) Since JP255's material is substantially the same as that of Applicants', both should possess the same properties including compression set, loss tangent, etc. Note that the intended uses of the material set forth in the instant claims do not carry any weight of patentability.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP255.

JP255 discloses a sealing material, supra, which is incorporated herein by reference. JP255 further teaches the use of a filler. ([0081]) JP255 is silent on the amount of the filler. However, the filler amount will affect the physical properties of the cured material. In other words, the filler amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a filler in whatever amount through routine experimentation in order to obtain a cured material having desired properties. Especially, Applicants do not show the criticality of the filler amount. See MPEP 2144.05 (II).

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9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez (US 4 394 853) in view of JP255.

Lopez discloses an automobile engine oil pan sealed by a unitary resilient **vibration absorbing** seal. (col. 2, lines 42-51) Lopez is silent on the specific material set forth in the present invention for the seal. However, JP255 teaches a sealing material, supra, that has **vibration absorption** capability for using in automobile engines. ([0086]) The motivation of using the sealing material is to dampen the vibration caused by the engines. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's sealing material for Lopez's oil pan seal material with expected success.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delle (US 5 731 069) in view of JP255.

Delle discloses an automobile wire harness sealed by an **acrylate**-containing sealing material where **vibration suppression** is desirable. (col. 2, lines 40-56 and col. 4, line 66 to col. 5, line 8) Delle is silent on the use of the specific material set forth in the present invention for the seal. However, JP255 teaches a sealing material, supra, that has **vibration absorption** capability for using in automobiles.

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([0086]) The motivation of using the sealing material is to dampen the vibration. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's sealing material for Delle's wire harness seal material with expected success.

11. Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bae (US 2001/0028527) in view of JP255.

Bae discloses an HDD containing a cover gasket for restraining **noises** and **vibration** generated in a base from transferring to the cover. ([0026]) Bae is silent on the use of the specific material set forth in the instant claims for the gasket. However, JP255 teaches a sealing material, *supra*, that has **vibration and noise absorption** capabilities for electronic devices. ([0086]) The motivation of using the sealing material is to dampen the vibration and/or reducing the noises. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's sealing material for Bae's gasket material with expected success. For Claim 24, "for use in mounting HDD's n automobiles" is merely an intended use, and does not carry any weight of patentability.



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12. The "X" references cited in the international search report are not relied upon because of the following reasons:

JP 2000-154370, EP 1182215, WO 01/059011, JP 2000-154347 and JP 08-134360 are not relied upon because their disclosures are no better than JP 2000-154255 that is applied for rejection above.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
May 24, 2006



Kuo-Liang Peng  
Primary Examiner  
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